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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,223	06/23/2000	Eric Blank	B0651/7005 REH	9973

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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/602,223

Applicant(s)

BLANK, ERIC

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/16/02 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14,16-29,31-53,57 and 59-80 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-14,16-29,31-53,57,59-80 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed September 16, 2002. Claims 15, 30, 54-  
5 56, and 58 are cancelled. Claims 1-14, 16-29, 31-53, 57-80 remain for examination.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- 10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated  
15 by the manner in which the invention was made.

2. Claims 1-14, 21-27, 29, 31-34, 38-53, 57, and 59-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warther et al. (US 6,039,356) in view of Leighton (US 6,036,099).

Re claims 1, 5, 11-14, 21, 27, 29, 31, 53, 57, 59, 62, 63, 68-70, 75-80, Warther teaches a  
20 rectangular transaction card (col. 1, lines 23+) with varying embodiments. As shown in figure 12, the card is composed of the main card 71a and auxiliary member 72c, which is connected to the main card on longer edge. Both main and auxiliary card contains machine readable codes 21a and 22c (barcodes), and the main card can be applied with magnetic strip (col. 7, lines 40+).

Warther fails to specifically teach or fairly suggest that the transaction card meets  
25 ANSI/ISO standard.

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Leighton teaches of producing a transaction card such as ATM cards (col. 1, lines 24+), wherein the surface roughness is within ANSI and ISO standard (col. 3, lines 27-33).

In view of Leighton's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ such well-known industry standards to the teachings of Warther in order to gain acceptance and increase marketability of the product. Furthermore, a product manufactured according to the industry standard improves interchangeability and can be readily used as a component part of a bigger system. Accordingly, one of ordinary skill in the art would adopt such standards in order to efficiently market their products and improve sales.

Re claims 2-4, 38-40, 45, 48, and 65, as shown in figure 12, machine readable code 21a is near a side opposite the auxiliary member 72c, and a scoring line 403. The auxiliary member contains an opening 72d (col. 10, lines 37+), and the card can be used as a key-tag.

Re claims 6 and 64, in another embodiment shown in figure 2, the main card and auxiliary card is approximately the same size.

Re claims 7, 10, and 67, the auxiliary member contains an opening 72d (col. 10, lines 37+), and the card can be used as a key-tag.

Re claims 8, 46, and 66, Warther further teaches a signature strip (col. 9, lines 59+).

Although

Re claims 9, 47, and 53, the card can be a store credit card, transaction card, or a membership card (col. 1, lines 23+). The card can obviously be purchased and given as a gift.

Re claims 16-18, 22, 32-35, 51, 52, 60, 61, and 72-74, Warther further discloses that auxiliary member can be a adhesive label (col. 1, lines 23+; col. 2, line 50 – col. 3, line 4), which

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contains corresponding code. The adhesive label can be removed and attached to another surface.

Re claims 23-25, 41-44, and 64, as shown in figures 8 and 2, auxiliary card can be joined at the long or short edge of the main card, and the size can be smaller or equal.

5 Re claims 49, 50, and 71, the card contains magnetic strip (col. 7, lines 40+) or the indicia only detectable by an optical reader (col. 6, lines 60+).

3. Claims 19, 20, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warther et al. (US 6,039,356) by Leighton (US 6,036,099) as applied to claim 1 above, and  
10 further in view of Klure (US 6,328,341). The teachings of Warther as modified by Leighton have been discussed above.

Warther/Leighton fails to specifically teach or fairly suggest that the label obscures a PIN number for a prepaid telephone account.

Klure teaches a prepaid telephone card 10 (see abstract; col. 1, lines 14+), whose pin  
15 number 14 is hidden until a customer purchases and opens the package.

In view of Klure's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate a notoriously old and well-known PIN number to the teachings of Warther in order to securely protect the value of the prepaid card, and protect the customers. PIN number activated cards and accounts are very well known in the art,  
20 and many cards/account are initially in deactivated state. Once a customer calls the service center or enter a correct PIN number, then the account is activated. Accordingly, such modification would have been an obvious extension as taught by Klure to protect both consumer and service provider from fraudulent use. Although Klure does not specifically teach obscuring

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PIN with a label, PIN is still protected within foldable jacket, which can be achieved by placing the label over the PIN in case of Warther.

*Response to Arguments*

- 5     4.     Applicant's arguments filed September 16, 2002 have been carefully considered, but they are not persuasive.

Examiner appreciates the Applicant's amendment and response to 35 U.S.C. §112 rejection in previous office action. As the Applicant kindly explained, Examiner agrees that mere use of phrase "adapted to" in the claims does not render the claims vague and ambiguous.

10     Accordingly, regardless of the amended claims, §112 rejection is withdrawn.

Applicant argues that the cited references to Warther et al. (US 6,039,356) and to Leighton (US 6,036,099) does not suggest edge roughness specified in ANSI and ISO standard (see page 4, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs), and traverses the rejection in last Office Action (paper #8),

15     As shown in Leighton (col. 3, lines 27+), ATM card surface smoothness/roughness is within ISO and ANSI standard. It is examiner's view that the surface includes the edges, although not explicitly suggested. When such treatment is applied on the card, it would be obvious to one of ordinary skill in the art to apply such treatment in all areas – front, back and edges. It would be unreasonable to manufacture a card having a portion of the card meet ISO/ANSI standard, and other parts of the card not adhered to the same standard.

20     Applicant further argues that "the type of scoring disclosed in Warther, e.g., at col. 7, lines 61-63 are not disclosed to be suitable for allowing separation such that the transaction card would meet specifications for edge roughness" (page 7, line 1+). Examiner points out that the

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scoring is disclosed by Warther, and edge roughness/smoothness is taught by Leighton. As suggested by Warther in view of Leighton, scoring with edge roughness claimed in the instant application is still anticipated.

The amended claims and remarks describing these elements have been fully considered,  
5 but they are not persuasive, and therefore, the Examiner has made this Office Action final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
15 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The  
20 examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-  
25 7724, or (703)308-7382.

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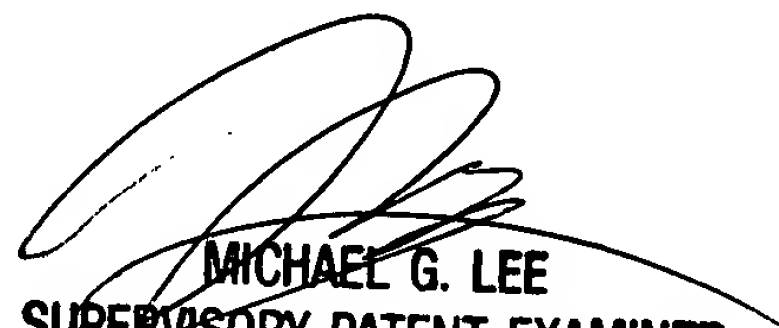
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

5 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



15 Ahshik Kim  
Patent Examiner  
Art Unit 2876  
November 11, 2002



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